

REMARKS/ARGUMENTS

Applicant respectfully requests reconsideration of this application in view of the present amendments and the following remarks. By this amendment, claims 1, 9, 17, 25, 33 and 41 are amended. Upon entry of the amendments, claims 1-49 are pending and at issue, with claims 1, 9, 17, 25, 33 and 41 being independent claims. It is believed that no additional fees are due for the consideration of this paper. However, if additional fees are due, the Commissioner is authorized to charge such fees to deposit account number 13-2855. A copy of this paper is enclosed.

Amendments to the Claims

It is respectfully submitted that the claims as amended above are supported by the application as originally filed in the Patent Office on January 16, 2001, that the amended claims satisfy the written description requirement and the other requirements of 35 U.S.C. § 112, and that no new matter is being added. Independent claims 1, 9, 17, 25, 33 and 41 are amended hereby to more clearly recite that the value-dispensing mechanism dispenses the bonus payout and not the currency payout to the user prior to returning to the main gambling game. As a result, the bonus payout may be dispensed or distributed to the user separately from any currency payout associated with the outcome of the main gambling game. These revisions to claims 1, 9, 17, 25, 33 and 41 are supported in the specification as originally filed at least at FIG. 11 and the accompanying text at page 16, line 26 through page 18, line 21, wherein the processor 70 may dispense a bonus round game award based on various criteria instead of applying the bonus round award or credits toward playing the main gambling game. Therefore, Applicant respectfully submits that the amendments to claims 1, 9, 17, 25, 33 and 41 do not present new matter and do not raise new issues, and respectfully requests entry of the present amendments to claims 1, 9, 17, 25, 33 and 41 and consideration of the claims as amended.

Response to Claim Rejections

In the final Office action of April 21, 2003, claims 1, 2, 7, 9, 10, 15, 17, 18, 23, 25, 26, 31, 33, 34, 39, 41, 46, 48 and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Slomiany *et al.* (U.S. Patent No. 6,159,098) in view of Gilmore *et al.* (U.S. Patent No. 6,347,996), claims 3-5, 11-13, 19-21, 27-29, 35-37 and 42-44 were rejected under 35 U.S.C. §103(a) as being unpatentable over Slomiany *et al.* in view of Gilmore *et al.* and in further view of Walker *et al.* (U.S. Patent No. 6,011,041), claims 6, 14, 22, 30, 38 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Slomiany *et al.* in view of Gilmore *et al.* and in further view of Burns *et al.* (U.S. Patent No. 6,048,269) and Saunders *et al.* (U.S. Patent No. 6,340,331), and claims 8, 16, 24, 32, 40 and 47 were rejected under §103(a) as being unpatentable over Slomiany *et al.* in view of Gilmore *et al.* and in further view of Adams (U.S. Patent No. 6,113,098). Applicant respectfully traverses the rejections of claims 1-49 and respectfully submits that claims 1-49 as amended herein would not be properly rejectable over the applied references for the following reasons.

Regarding the rejections of all claims 1-49 over Slomiany *et al.* in view of Gilmore *et al.*, either alone or in combination with Walker *et al.*, Burns *et al.*, Saunders *et al.* and Adams, applicant respectfully submits that the Slomiany *et al.* and Gilmore *et al.* references do not disclose or suggest dispensing a bonus payout, and not a currency payout of a main gambling game, to the user from a value-dispensing mechanism after determining the bonus payout and prior to returning to the main gambling game as recited in the claims. The Examiner contends that Slomiany *et al.* “meets this limitation because, upon completion of the bonus game, the gaming system dispenses the bonus credits earned in the bonus game by a value-dispensing mechanism to a credit meter.” Applicant respectfully submits that the Examiner’s contention misinterprets the language of independent claims 1, 9, 17, 25, 33 and 41.

During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 21 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000); *see also*, MPEP § 2111. The broadest

reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999). Those skilled in the art reading the currently pending claims in view of the specification would distinguish between dispensing the bonus payout or value to the user from a value-dispensing mechanism and accumulating credits earned in the bonus game on a credit meter. The specification describes the value-dispensing mechanism as follows:

The value-dispensing mechanism may be capable of dispensing any suitable objects that may be representative of some monetary value, such as paper currency, coins, tokens, gaming machine credit, tickets for shows, meals, casino service, hotel services, and the like. For example, the value-dispensing mechanism may be a printing apparatus capable of printing an award ticket and the award ticket may be printed and dispensed after the bonus award is determined automatically or based on information that may be acquired from selections made by the user at the input device or on information obtained from a player tracking system via a player tracking interface that may be included in the electronic gambling unit. Alternatively, the value-dispensing mechanism may be capable of dispensing value by incrementing value on an item having data stored thereon or value maintained in a player tracking system.

Specification, page 3, lines 5-16. The specification also distinguishes between dispensing value to the user and incrementing the credits available on a gaming machine. *See, e.g.*, Specification, page 8, lines 18-21. ("If the gambling unit then determines the outcome of the game is a 'winner,' a winning combination of symbols is displayed to the user and the gambling unit 10 pays out either by dispensing value to the user or by incrementing the number of credits available to the user to wager on the game."). The specification further describes the dispensing of bonus round credits or payouts as follows:

If the processor 70 determines the bonus round credits are to be redeemed at block 364, control passes from the block 364 to a block 366, which determines the manner for converting the bonus credits into value. As with the previous determination regarding whether to redeem the bonus credits, the processor 70 at block 366 may use

information from various sources to determine the manner or medium for dispensing the bonus credits to the user, including the configuration of the bonus round game, information entered by the user at the touch-sensitive display unit 14, and user profile information from the users smart card or the player tracking system. Based on the relevant information, the bonus credits may be redeemed by dispensing coins, tokens or currency at the coin tray 40 or bill validator, dispensing tickets or coupons, either pre-printed or printed by the printer 46 and having either a cash value or credit for or toward goods or services available at the gaming establishment, adding cash or credit to the user's smart card or player tracking profile, or otherwise rewarding the user for bonus credit accumulated during the bonus round game.

Specification, page 17, line 29 through page 18, line 13. One skilled in the art would understand that a value-dispensing mechanism dispensing a bonus payout to the user is distinct from accumulating credits on a credit meter. Slomiany *et al.* appears to teach the awarding or accumulation of coins or credits, but neither discloses nor suggests that any award from the bonus game is actually dispensed from the gaming machine to the user without also dispensing the currency payout for the main gambling game.

The Gilmore *et al.* reference fails to provide the disclosure or suggestion missing from the Slomiany *et al.* reference of dispensing a bonus game award prior to returning to a main gambling game. Gilmore *et al.* discloses a gaming machine having a basic game and a bonus feature. The Gilmore *et al.* reference discloses that the player may collect the amount of **accumulated credits** by pressing the "Collect" button 60. Gilmore *et al.*, col. 3, lines 39-41. Gilmore *et al.* teaches away from dispensing a bonus payout separately from any other accumulated credits by disclosing an all-or-nothing cash out or collect button. It follows, therefore, in the opinion of the applicant that the Slomiany *et al.* and Gilmore *et al.* references applied by the examiner neither anticipate nor render obvious claims 1-49 and in fact teach away from the invention recited in these claims. *See In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985) (the prior art must make a suggestion of or provide an incentive

for the claimed combination of elements in order to establish a *prima facie* case of obviousness).

The additional applied references, Burns *et al.*, Saunders *et al.* and Adams, do not provide the necessary teaching or suggestion missing from Slomiany *et al.* and Gilmore *et al.* of an electronic gambling unit having a main gambling game and a bonus round game in which a value-dispensing mechanism dispenses a bonus payout to the user after determining the bonus payout and prior to returning to the main gambling game. The additional applied references do not appear to disclose or suggest a bonus game, let alone dispensing a bonus payout from a bonus game prior to returning to the main gambling game. Because the applied references do not appear to teach or suggest an electronic gambling unit having a main gambling game and a bonus round game in which a value-dispensing mechanism dispenses a bonus payout to the user after determining the bonus payout and prior to returning to the main gambling game, and in fact teach away from dispensing a bonus payout separately from any other accumulated credits, applicant respectfully submits that claims 1-49 are now in condition for allowance, and applicant respectfully requests allowance of these claims at the Examiner's earliest convenience.

Entry and consideration of the foregoing amendments as improving the form of the application are solicited. The amendments have the effect of narrowing the issues for consideration by Examiner Ashburn on appeal, and were not earlier presented because, prior to the final Office action and Examiner Ashburn's comments therewith, these amendments were not felt necessary to obtain allowance.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection of the claims and allowance of the currently pending claims are respectfully requested. Should the Examiner wish to discuss the foregoing or any matter of form in an effort to advance this application towards allowance, she is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

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